

REMARKS

This paper is submitted in response to the Office Action dated February 3, 2009 (the "Office Action").

Claims 1, 3-11, 13-30, 33-37, 39-45, 48-52, and 54-60 are pending, including new claim 60.

Claims 54-56 stand rejected.

Claims 1, 3-11, 13-30, 33-37, 39-45, 48-52, and 57-59 have been allowed.

The amendments add no new matter. The above amendments have been made to address matters of form and to more clearly set forth the claimed subject matter. While not conceding that the cited reference(s) qualify as prior art, but instead to expedite prosecution, Applicant has chosen to respond as follows. Applicant reserves the right, for example in a continuing application, to establish that the cited reference(s), or other references cited thus far or hereafter, do not qualify as prior art as to an invention embodiment previously, currently, or subsequently claimed. Applicant respectfully submits that the pending claims are allowable in view of the following remarks and the above amendments, and respectfully requests reconsideration of the pending rejections.

Formal Matters

Applicant had previously amended claims 21 and 54 to be in independent form, in Applicant's previous amendment dated September 14, 2006. However, Applicant's undersigned representative had inadvertently not paid the required fee for these independent claims. The

September 14, 2006 submission did include, in the transmittal letter, a request and authorization to pay any such required fees from a deposit account. In accordance with this request, the Office charged the required fee of \$420.00 from Applicant's representative's deposit account 502306 on November 6, 2008. Applicant gratefully acknowledges this requested and authorized charge.

Allowed claims

Applicant expresses continued gratitude for the indication that claims 1, 3-11, 13-30, 33-37, 39-45, 48-52, and 57-59 are allowed. Applicant submits that these claims continue to be in a condition for allowance. In particular, Applicant draws the Examiner's attention to allowed independent claims 24 and 39. Applicant respectfully submits that claims 24 and 39 are allowable over the cited portions of the reference(s) at least for reasons similar to those below with regard to independent claim 54.

Rejection of Claims under § 102(e)

Claims 54-56 stands rejected stand rejected under 35 U.S.C. § 102(e) as purportedly being anticipated by U.S. Patent No. 5,991,276 issued to Yamamoto. ("Yamamoto"). Applicant respectfully submits that the claims are allowable under § 102(e) because the cited passages of Yamamoto fail to disclose each limitation of the pending claims.

As an initial matter, the pending rejections fail to comply with the requirements for a rejection under § 102(e). The *Code of Federal Regulations* clearly and explicitly provides that:

In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of

each reference, if not apparent, must be clearly explained and each rejected claim specified.

37 C.F.R. § 1.104(c)(2) (emphasis added). The “must” language in this rule makes clear that designating the particular part of a reference on which a rejection relies is not at all optional under § 102(e).

Applicant respectfully submits that the particular parts of the cited reference that the Office Action has relied upon have not been designated as nearly as practicable, as required by 37 C.F.R. § 1.104(c)(2). In particular, the Office Action does not clearly indicate what features of the cited reference are alleged to correspond to many of the limitations in Applicant’s claims.

With regard to Applicant’s independent claim 54, the Office Action cites a series of lengthy excerpts from Yamamoto (2:65—3:35; 4:33-47; 8:64—9:11; and 9:58—10:47) without pointing to any particular features therein, as purportedly reading on Applicant’s limitations of:

receiving at an initially unavailable network station client
a persistent invitation to join an ongoing conference call, wherein
the receiving . . . occurs after the ongoing conference call has
begun

receiving a token indicative of the persistent invitation to join the
ongoing conference call at the initially unavailable network station
client.

(Emphasis added.)

However, the Office Action fails to discuss, or even mention, any particular features of these lengthy passages that purportedly correspond to Applicant’s limitations. In particular, the Office Action is silent regarding what features of Yamamoto are purported to correspond to Applicant’s “persistent invitation” or “token indicative of the persistent invitation.” The rejection of claim 54 thus falls far short of the requirements for a rejection under § 102(e) as set

forth in 37 C.F.R. § 1.104(c)(2). At least for this reason, the pending rejections under § 102(e) should be withdrawn.

If the Examiner wishes to maintain the pending rejections in a future Office action by providing explanations that support the rejections with the mandatory degree of particularity (“as nearly as practicable”) required by 37 C.F.R. § 1.104(c)(2), then those explanations should be provided in a subsequent non-final Office action, because they are not being necessitated under § 706.07(a) of the *Manual of Patent Examining Procedure* (ed. 8, rev. 7, Jul. 2008) (“MPEP”) by Applicant’s above amendments or by an IDS filed by Applicant, and because only a non-final Office action would provide Applicant a full opportunity to respond to the effectively new grounds for rejection.

Nevertheless, Applicant makes every effort herein to address the rejections outlined by the Office Action. Applicant respectfully submits that the cited passages of Yamamoto fail to disclose each limitation of Applicant’s independent claim 54.

The Office Action appears to equate the “initially unavailable network station client” in Applicant’s claim 54 with user terminal 6b in Yamamoto. Even if this understanding of the cited art is appropriate (a point which Applicant does not concede), the cited passages of Yamamoto nonetheless fall short of disclosing Applicant’s “persistent invitation” or “token indicative of the persistent invitation.”

The cited passages of Yamamoto teach that at the opening of a scheduled videoconference, videoconference administration server 10 makes access to the participant user terminals; if user terminal 6a responds within a predetermined time period and accepts the participation request, connection paths are established between user terminal 6a and

videoconference server 9a. *See*, Yamamoto, 9:58—10:24. The cited passages also discuss situations in which a user terminal does not respond:

FIG. 12 is a sequence diagram showing a procedure that is executed when a user terminal returns silence or a busy signal in response to an access request from the videoconference administration server 10 in the path establishment procedure. The following will explain the operations performed in this procedure, in accordance with the sequence numbers shown in FIG. 12.

[S21] As in the above-described sequence S12, the videoconference administration server 10 makes access to a participant user terminal, say 6b, using the SVC services via the signaling channel. If the user terminal did not answer within a certain time period or returned a busy status signal in response to the access, the video-conference administration server 10 will repeat the same access after a predetermined interval. The videoconference administration server 10 attempts this access repeatedly as long as the videoconference is continued.

Yamamoto, 10:32-48.

The cited passages of Yamamoto thus addresses a silent or busy user terminal by repeating an attempt to access the user terminal. Meanwhile, Yamamoto's videoconference can proceed, and can display images that inform other participants of the non-responding or busy user terminal: "The absence notification image data manager 54 generates an absence notification image which indicates that the system continues calling one of the user terminals, when it does not respond to the call or returns a busy status signal in response to the call." *See*, Yamamoto, 8:4-13.

The cited passages of Yamamoto thus teaches away from Applicant's claim 54. In particular, Yamamoto's repeated attempts to access a terminal are counter to Applicant's streamlined use of a "persistent invitation."

Applicant's persistent invitation can be used in various embodiments of the present invention to avoid the active repetition that is taught in the cited passages of Yamamoto. For example, Applicant's FIG. 5 illustrates an example in which a procedure uses a token and a camp-on application to implement a persistent invitation for User D. *See*, FIG. 5, blocks 508, 510, 512, 544, 546, and 548. This persistent invitation avoids the need for a repetition of or looping through blocks that determine whether User D is busy (block 506) or ring User D (block 534). Avoiding this needless repetition streamlines the operation of the example in Applicant's FIG. 5.

Instead of such streamlined operation, the cited passages of Yamamoto use repeated attempts to access a user terminal that does not respond to the call or that returns a busy status signal in response to the call. This wasteful operation arises specifically because cited passages teach that repeated attempts should be made, instead of using a single attempt such as Applicant's "persistent invitation," or a "token indicative of the persistent invitation." At least these limitations are therefore absent from the cited passages of Yamamoto. Accordingly, Applicant respectfully submits that claim 54, and all claims dependent therefrom are allowable under § 102(e).

New claim

New claim 60 includes:

- a token generator configured to extend a persistent invitation to a first network station client to join an ongoing conference call; wherein:
 - the persistent invitation is extended in response to a determination that the first network station client is unavailable to accept a non-persistent invitation to join the ongoing conference call,
 - the persistent invitation is extended after the ongoing conference call has begun,

the persistent invitation comprises a token issued to the first network station client, and

the token is configured so that an activation of the token by the first network station client initiates adding the first network station client to the ongoing conference call.

At least in view of these limitations, Applicant respectfully submits that new claim 60 is also allowable.

CONCLUSION

In view of the amendments and remarks set forth herein, the application and the claims therein are believed to be in condition for allowance and a notice to that effect is solicited.

Nonetheless, should any issues remain that might be subject to resolution through a telephonic interview, the Examiner is invited to telephone the undersigned at 512-439-5097.

If any extensions of time under 37 C.F.R. § 1.136(a) are required in order for this submission to be considered timely, Applicant hereby petitions for such extensions. Applicant also hereby authorizes that any fees due for such extensions or any other fee associated with this submission, as specified in 37 C.F.R. §§ 1.16 or 1.17, be charged to deposit account 502306.

Respectfully submitted,



Cyrus F. Bharucha
Attorney for Applicant
Reg. No. 42,324
Telephone: (512) 439-5097
Facsimile: (512) 439-5099